

89-1504 (1)

Supreme Court, U.S.

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CLERK

No. _____

IN THE
SUPREME COURT OF THE UNITED STATES
OCTOBER TERM, 1989

JOSEPH W. NEWMAN

PETITIONER

VS.

DONALD J. QUIGG, Commissioner
of Patents & Trademarks - RESPONDENT

PETITION FOR WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE FIRST CIRCUIT

JOSEPH W. NEWMAN
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H7P2



QUESTION PRESENTED

A. DOES EMPLOYEES OF THE U.S. PATENT & TRADEMARK OFFICE HAVE THE RIGHT TO PREMEDITATEDLY AND DELIBERATELY VIOLATE THE CONSTITUTION OF THE UNITED STATES OF AMERICA AND THE VERY ESSENCE AND ONLY PURPOSE OF THE EXISTENCE OF THE FOUNDING OF SAID OFFICE BY CONGRESS AS EXPLICITLY STATED IN SECITON 8 OF ARTICLE I OF SAID CONSTITUTION BY DELIBERATELY WITHHOLDING THE EXCLUSIVE RIGHT TO AN INVENTOR OF THE FRUITS OF LABOR OF A PIONEERING DISCOVERY AND COMPOUNDING SAID VIOLATION BY DELIBERATELY AND PREMEDITATEDLY VIOLATING ARTICLES VII AND VIII OF THE BILL OF RIGHTS OF THE CONSTITUION OF THE UNITED STATES OF AMERICA BY DENYING INVENTOR TRIAL BY JURY AND SIMULTANEOUSLY INFLECTING EXCESSIVE FINES AND UNUSUAL PUNISHMENT OF EXTREME MONETARY LOSS AND EXPENSES AND YEARS OF MENTAL INJUSTICE TO SAID INVENTOR?

PARTIES

NAMES OF ALL PARTIES APPEAR IN THE CAPTION OF THE CASE.

(i)

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PETITION FOR A WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

Petitioner, JOSEPH W. NEWMAN, respectfully prays that a writ of certiorari issue to review the judgment and opinion of the United States Court of Appeals for the Federal Circuit entered in the above-entitled cause on July 5, 1989 and modified on September 29, 1989.

I.

OPINION BELOW

The opinion and its modification of the Court of Appeals is attached as Appendix A and B. The District Court's constitutional violation order of awarding \$100,000.00 plus costs against me is attached as Appendix C.

II.

JURISDICTION

The opinion of the Court of Appeals for the Federal Circuit was filed in July 5, 1989 and rehearing requested by Respondent was denied in part and granted in part on September 29, 1989. The jurisdiction of this Court is invoked pursuant to 62 Stat. 928, 28 U.S.C. §1254, 28 U.S.C. §2101, Article III of the Constitution of the United States, Rule 20, 28 U.S.C. §1651(a), Federal Rule of Civil Procedure 53(e)(2). And extension of time to January 27, 1990, was granted by this Court to file the petition. Informal was timely filed and this Document in proper form was thereafter timely filed.

III.

CONSTITUTIONAL PROVISIONS

Section 8 of Article I of the United States Constitution provides:

The Congress shall have Power...

"To promote the Progress of Science and useful Arts; by securing for limited times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."

Article VII of Bill of Rights of the United States
Constitution provides:

“In suits at common law, where the value in controversy shall exceed twenty dollars, the right of trial by jury shall be preserved, and no fact tried by a jury shall be otherwise re-examined in any court of the United States than according to the rules of the common law.”

Article VIII of Bill of Rights of the United States
Constitution provides:

“Excessive bail shall not be required, nor excessive fines imposed, nor cruel and unusual punishments inflicted.”

IV.

STATEMENT OF FACTS

The Externally “More Out Than Externally In/ $E=mc^2$ ”
Invention

I, Newman, an independent inventor, have had a substantial background in patents, having been the patentee of a number of commercialized inventions (Newman Summary Judgment affidavit). However, they pale in comparison to the results of my

20+ years of work on the invention now in issue.

Such “more out than externally in” has never been achieved before in an electromagnetic device, but has been achieved in other applications, including atomic fissure (e.g. atomic bomb & reactor) and fusion (e.g. hydrogen bomb) by converting some of the matter internal to the device into energy, in accordance with Einstein’s accepted equation of $E=mc^2$. More “out than externally in” ipso facto is not contrary to accepted scientific law, ever since the acceptance of Einstein’s theories and the establishment of the conversion of matter into energy.

I, Newman, explained this conversion of matter into energy and other aspects of the operation of my invention in connection with my Figure 5 embodiment in my patent application, as follows:

“It is very important to understand that, the longer the length of the conducting wire in coil 205, the stronger will be the magnetic field produced and the less electric current that will complete the circuit and get back into the battery and destroy the mechanical source of the electrical current. This effect can be increased further by increasing the diameter of the conducting wire in coil 205 and then greatly increasing its length still further in the coil.

Reason: The gyroscopic particles making up the electric current interact with the atoms of coil 205. The more atoms in coil 205, relative to length, the longer it takes the gyroparticles of the electric current, to influence them and get out the other end of the

coil. It is then easily seen that, if the direction of the current into coil 205 is then reversed, this then even increases this lag time. Reason: The gyroscopic particles have inertia and are believed to be moving at the speed of light and are interacting with the gyroscopic particles making up the atoms of conducting coil 205. These atoms also have inertia and, when the direction of current is reversed into coil 205, the incoming current then collides with the current already in coil 205 going in opposite directions.

This causes a brief hesitation during the time the current already in the coil is being forced to reverse its direction, thereby then reversing the direction of the atoms within coil 205 which have already been influenced to become aligned. This causes a constant force throughout the circuit, but does not allow very much current to get back into the battery 201 to destroy the mechanical means which initiated the release of electric current in the first place.

Therefore, it should be further understood that, the faster the current direction reverses into the coil 205, the more efficiently the matter of battery 201 is converted into pure electrical energy ($E=mc^2$), without destruction of the mechanical situation that initiates the electrical current release.

It is also important to understand that, the stronger the magnetic field coming from the mass of magnet 200, the greater will be its rotational speed. Additionally, the greater the magnetic field coming from the mass of coil 205, the greater will be the rotational speed of magnet 200, and, up to a point, the greater the electric current input from battery 201, the greater will be the percentage of the atoms making up coil 205 that are aligned. This probably has the same relationship as does achieving atom alignment in conventional magnetic materials. Once complete atom alignment is reached in coil 205, no amount of current will cause those atoms to increase the strength of the magnetic field emitting from those atoms.

Therefore, it should be clear that, for a given input of electric current from battery 201, the most efficient design is one in which the most atoms of coil 205 are influenced to atom alignment by that given electric current, which means increasing the diameter and the length of the conducting wire of coil 205 to the point that the strength of the magnetic field produced is sufficient to cause rotation

of the magnet 200 to a speed that allows none or at least very little of the electric current which initially comes from the battery 201 and destroy or reduce the mechanical effect which induced the conversion of the matter of battery 201 in electric current in the first place."

Professor Roger Hastings, a physicist, at trial testified that:

"The most important design rule specified by the inventor is that the length of wire in the motor coil be very long; preferably long enough so that the switching time between current reversals is shorter than the time required for the propagation of the current wavefront through the coil. Various models contain up to 55 miles of wire, with air core coil inductances of up to 20,000 henries."

In this configuration, Professor Hastings testified:

"The permanent magnet armatures have very large magnetic moments. Thus the motors exhibit high torque with low current inputs. The motors generate large back current spikes consisting of pulsed r.f. (radio frequency) in the 110-20 MHz (megahertz) frequency range. These spikes provide large mechanical impulses to the rotor, energize fluorescent tubes placed across the motor, and tend to charge the drycell battery pack."

As a result, Professor Hastings concluded:

"The total generated energy, consisting of, (a) mechanical, (b) mechanical friction, (c) ohmic heating and (d) light is many times larger than the battery input energy."

See Appendix D.

My life's work of this Pioneering Invention is of such great significance it will change in a phenominally beneficial way the entire economic position of all Peoples of this earth, eliminate pollution, make space travel a practical reality, eliminate hunger, and do more to bring World Peace than all the Kings, Politicians, Presidents, Dictators, etc., who have ever lived.

I sincerely ask the Honorable Supreme Court to hear the meritorious case of my Life's Work concerning a "Pioneering" Revolutionary Energy Invention, that is of tremendous benefit to all of Humanity. The following quotes are only a sample of the numerous competent scientific minded individuals over the years, who have studied my Life's Work and have so verified:

"The future of the human race may be dramatically uplifted by the large-scale commercial development of this invention." - DR. ROGER HASTINGS, Principal Physicist, SPERRY CORPORATION.

"If the manner in which Joseph Newman conducted his experiments and the results were made known to the

industrial or engineering community then, in my opinion, several companies and/or individuals possess the expertise and capabilities to construct the hardware required to fully exploit the apparent capability of his new concepts.” - DR. ROBERT E. SMITH, Chief, Orbital and Space Environment Branch, George C. Marshall Space Flight Center, NASA.

“You have opened an area in Astrophysics which may revolutionize the magnetic energy problem which is now the most paramount problem in future energy and space travel. I do believe with proper research funds, the results would not only be a great financial boom to your financiers, but would lead to developments that will be practical and beneficial to all mankind and develop a new step in science.” - DR. E. L. MORAGNE, MORAGNE RESEARCH & DEVELOPMENT COMPANY, (Electromagnetic pioneer in the development of the first atomic bomb).

“Mr. Newman has demonstrated many working models of his invention, an ‘energy machine’ which is based on his own ideas. This invention means an unlimited source of energy and will introduce new ideas into the science of physics.” -

DR. NICHOLAS TSOUPAS, Physicist, A.W. Wright
Nuclear Laboratory, YALE UNIVERSITY.

There have been more than 30 independent scientific minded individuals, who have come to my home and scientifically tested said "Pioneering" Energy Invention and verified it works!

Said numerous tests caused the SPECIAL MASTER chosen by the Lower District Court of Columbia, and had said his credentials were superb, who was nominated by Respondent, and who, himself had been a former Commissioner of Patents & Trademarks, and who had an Electrical Engineering background, to state:

"Evidence before the Patent and Trademark Office and this Court is overwhelming that Newman has built and tested a prototype of his invention in which the output energy exceeds the external input energy; there is no contradictory factual evidence."

I had originally asked for trial by jury, which was denied and I had objected to the Lower Court's hiring a Special Master, as I knew it would cost me additional money and I had 30 competent, independent eyewitnesses to the operability of said "Pioneering" Energy Invention and the Respondent had zilch.

When Respondent was challenged by this fact, Respondent quoted U.S. Patent Law as to what they were directed to

do - U.S. Patent Office has no facilities for testing an invention and must depend upon affidavits of operability presented by applicant - While totally ignoring the fact Respondent had consistently violated said Patent Laws and had discounted all testing by applicant and other numerous independent scientific minded individuals by claiming we were all incompetent or possibly deliberately being misleading.

Such violations by Respondent had caused the Special Master to rule:

“Defendant intentionally did not consider the formalities of Plaintiff’s application or the patentability of Plaintiff’s claims under 35 USC sec. 102/103.”

Along the same line of chastisement against Respondent the Special Master ruled:

“Key to the decision of the Board of Appeals is its findings that a motor like Figure 6 of Newman’s application ‘would not and could not be made to operate at an efficiency level greater than 100% as recited for example in generic claim 43. Such a machine is impossible.’” That finding is clearly erroneous.”

The Lower District Court had stated it had no scientific expertise of the field and that the hiring of a Special Master would save me funds.

I was charged more than \$11,000.00 for said SPECIALMASTER and then the Lower District Court threw out the findings of the SPECIAL MASTER, without any evidence from Respondent against the SPECIAL MASTER FINDINGS, other than irresponsible remarks inferring the SPECIAL MASTER "believed in the Tooth Fairy."

Said action of the Lower Court was not only a violation of Federal Law, (F.R.C.P. 53)¹ concerning the hiring of a SPECIAL MASTER, but was also a violation of the Lower Court's reason for hiring said SPECIAL MASTER over my objection.

The Lower Court then demanded I send a prototype of said "Pioneering" Energy Invention to a Biased and Prejudiced sister office of Respondent - The National Bureau of Standards. Both the Respondent and its sister office - National Bureau of Standards were already on the Lower Court Record testifying without ever testing said "Pioneering" Energy Invention, that its operability was "Impossible."

The Lower District Court's actions were so unjust, I filed Writs of Mandamus to the Higher United States Court of Appeals for the Federal Circuit. Said Higher Court upheld in part

¹ "In an action to be tried without a jury the court shall accept the master's findings of fact unless clearly erroneous."

one of said Mandamus concerning the testing of said "Pioneering" Energy Invention and even at a later date pointed out that the National Bureau of Standards were coming into said testing with a prejudiced opinion, as they had even inferred to said Higher Court that I was a fraud, (In re Newman, 782 F.2d 971 (Fed. Cir. 1986)).

Said prejudiced illegal testing by the National Bureau of Standards deliberately followed a procedure of grounding all tests of said "Pioneering" Energy Invention, which they knew from prior Deposition Testimony would dump all excess energy of said "Pioneering" Energy Invention and cause the false results to indicate it was not operable.

Said deliberate, hostile, and unjust action by the Respondent and sister office - National Bureau of Standards is screamingly exemplified by them presently and said Lower District Court attempting to charge me more than an additional \$100,000.00 for their said unjust actionx (See Appendix C). Said horrifying ridiculousness is exemplified by any competent electrical engineering being able to totally test said "Pioneering" Energy Invention in a very short time at virtually no cost. More than 30 competent independent individuals have already done so! This is a blatant violation of Article VIII of the Amendments to the Constitution of the United States.

Said unjust action even of this date by said Lower District Court exemplifies why I was correct in not going to the Trial of my Life's Work at said Lower District Court protesting my absence, "was to accent the Lack of Justice in Said Lower District Court."

It is further exemplified in that as of this date I have spent close to One Million Dollars since filing for a patent on said "PIONEERING" Energy Invention in 1979 in trying to secure a just U.S. Patent and which has resulted in my being financially drained.

It should be noted that at the trial, the NBS tester (Dr. Heber) himself admitted that his tests may have been conducted wrongly, and that the Patent Officer's expert, Dr. Johnson, also admitted that, if in my device there was a conversion of matter through energy "as I had described in my patent application," my invention would not be in conflict with the accepted Laws of Physics, particularly of thermodynamics.

Finally, the Court criticized me for not cooperating with the NBS tests and somehow consider me bound by the results. However, these were not set up as "inter partes" tests, and the trial court never established any procedures or requirements that I comment on the NBS tests before they were run. Indeed, there was not cooperation even desired by the NBS, and I had to go to the

Appeals Court to prevent the NBS from having the right to destroy my machine or to keep it until after the trial! (In re Newman, 782 F.2d 971 (Fed. Cir. 1986).

I believed all along that the NBS tests were merely a bureaucratic setup and the fact that they only reported on tests the Patent Office knew would give false results and did not run a single one of the many different tests run by the 30+ scientists and technicians establishing that my invention worked, shows that the NBS tests were just a set-up.

In a "145" Proceeding the USPTO Record is the "Evidentiary Nucleus" -

As the district court noted (5 USPQ2d at 1885; Addendum II):

"A decision of the PTO Board of Patent Appeals, whether reviewed by way of a direct appeal to the U.S. Court of Appeals for the Federal Circuit under 35 U.S.C. Section 141 or a civil action to set it aside before the U.S. District Court for the District of Columbia pursuant to 35 U.S.C. Section 145, is presumptively correct. *Fregeau v. Mossinghoff*, 776 F.2d 1034, (227 USPQ 848) (Fed. Cir. 1985). It may be overturned only if 'clearly erroneous,' by which is meant that the reviewing court must be of the 'definite and firm conviction' that a mistake has been made. *Id.* at 1038, (227 USPQ at 851) (quoting *Anderson v. City of Bessmer City*, 470 U.S. 564, 573 (1985)). Review by the court of appeals is confined to the PTO record and the Board's decision. When new evidence is presented in a 'de novo' proceeding in a civil action in District Court, the record before the PTO is nevertheless the evidentiary nucleus', *id.* at 1037, (227 USPO at 85) which the court

must consider in conjunction with the evidence adduced at trial in making its independent findings of fact. Id. at 1038 (227 USPQ at 851)."

However, after correctly citing the law, the district court merely gave it "lip service." It then merely concluded, without detailing a single substantive consideration, iota of substantive evidence or analysis of any of the substantial evidence from the USPTO proceedings:

"This court, having made such a consideration, concludes, as did the Board, the Newman's device lacks utility (in that it does not operate to produce what he claims it does), and the Board's decision is not clearly erroneous."

What happened to the "overwhelming evidence," detailed above, found by the eminent Master supporting the operability of the invention? What happened to the "evidentiary nucleus?" What happened to the many tests by many different individuals, filed in the PTO record, all coming to the same conclusion that the invention worked?

Indeed, it is ironic that I am the only one that had the one test run that the Patent Examiner and the Patent Office said was the most important type of test, namely a "mechanical (break) output" test and it likewise confirmed that my device worked!

All of the foregoing unjust actions have caused Eleven U.S. Congressmen to introduce Bills on my behalf into Congress for the issuance of a "Pioneering" Patent on said Energy Invention.

I have been on numerous Television Shows, such as CBS, NBC, and ABC National News, CNN, The Johnny Carson Show, The Today Show, and others, numerous Radio Talk Shows across the country as well as Hundreds of written articles. News People, from Germany, Japan, Sweden, Australia, India and others have covered my Life's Work and said "PIONEERING" Energy Invention.

To make sure my Life's Work was not stifled by said above unjust actions, I published the same in a book I had written titled, "The Energy Machine of Joseph Newman." I have sold 7 thousand copies worldwide of the same majorly by word of mouth. More than 200 major entities, such as Corporations, Libraries, Military, etc., have purchased said Book.

I have made my livelihood by inventing since 1962 and have more than 6 U.S. Patents.

Contrary to said above unjust actions of the United States, I have received 7 Foreign Patents on my "PIONEERING" Energy Invention: Spain, India, Italy, Venezuela, Mexico, Argentina, and South Africa.

I have recently signed a contract for Manufacture of said "PIONEERING" Energy Invention, with a U.S. Company and others are now coming forward. One of their greatest concerns is whether I will be unjustly denied a U.S. Patent for my Life's Work.

V.

REASONS FOR GRANTING THE WRIT

Said unjust actions stated above have resulted in U.S. Companies prior to this time not to contract for Manufacture.

Said Higher Court of Appeals have upheld the unjust actions of said Respondent and said Lower District Court with the same blatantly false conclusion stating that said "PIONEERING" Energy Invention does not operate.

There is precedence for what I ask (U.S. Verses Adams, 383 U.S. 39, 15L Ed 2d 572, 86S. CT. 708 (1966)). To personally give a demonstration of a Production Model of said "PIONEERING" Energy Invention that is culmination of my Life's Work for all Humanity in the presence of the Honorable Supreme Court of the United States.

The file of this case is voluminous, but the issue is simple. Does said "PIONEERING" Energy Invention work. Said

Demonstration would use standard adequate testing equipment, to which if any convention electrical motor is hooked to and to a power source, the convention motor will be proven to draw current from the power source. Opposite to that, my "PIONEERING" Energy Invention will instantly be proven to be sending more current back to the power source than came from the power source.

To allow said stated injustice to stand is to send a blatant message for all time to every potential inventor, who knows it may take years of his life to perfect some "PIONEERING" Invention of Benefit to Humanity and that they can expect no Justice from the U.S. Patent Office or the Federal Court System of the United States. And that they can expect their Life's Work and the Fruits of their Labor to be openly encouraged to be stolen from them by others. And that their Constitutional Rights may be blatantly violated as to no trial by jury no matter the tremendous monetary value of their Discovery and to receive "excessive fines imposed," and "cruel and unusual punishment inflicted" for attempting to acquire their legal constitutioanl "exclusive Right to their respective Writings and Discoveries."

The above facts are exemplified as TRUTH by a quote from Mr. Paul Gomery (a long time Expert Advisor to the Judiciary Committee on Patent Law), who witnessed the Lower

District Court and Respondent not accepting Findings of Special Master, and when questioned by Newsmedia about the same in front of said Lower District Court House, stated: "There is not but one word for it, 'Atrocious.' Long ago the U.S. Patent Office should have issued this patent."

I have fully shown that the Patent Office was clearly erroneous in rejecting my patent application, and the Special Master's Findings of Operability of the same, and Respondent has not carried their corresponding evidentiary burden at the trial.

This is not the first time the Patent Office has stood in the way of a Revolutionary, Extremely Valuable Invention. The Patent Office also put Orville and Wilbur Wright through an expensive, multi-year battle continually claiming that it was impossible for man to fly. For years the Wright Brothers had in fact flown and had presented substantial evidence of their success to the Patent Office. (See "The Wright Brothers' Pioneering Patent," American Bar Association Journal, October 1979, Vol. 65, pp. 1512-1518.)

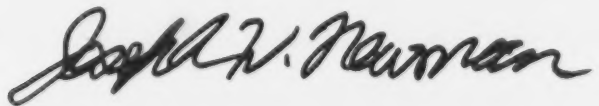
VI.

CONCLUSION

This case presents important constitutional issues regarding the stimulation of creativity of the individual by which the inhabitants of this nation benefit therefrom. This Court here has an opportunity to clarify this will be done in accordance with guidelines given in the Constitution of the United States. This case has established a dangerous precedent which if not corrected, will most definitely stifle creativity in this nation as said "Atrocious" injustice precedent will be a potential Guillotine over the mind of every Inventor of this country from this time forward.

I sincerely ask this Honorable Supreme Court of the United States to hear this meritorious case.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Joseph W. Newman", written in a cursive style.

DATED: February 21, 1990

JOSEPH W. NEWMAN

RT. 1, BOX 52

LUCEDALE, MISSISSIPPI 39452

APPENDIX A

United States Court of Appeals for the Federal Circuit

88-1312

JOSEPH W. NEWMAN,

Plaintiff-Appellant,

v.

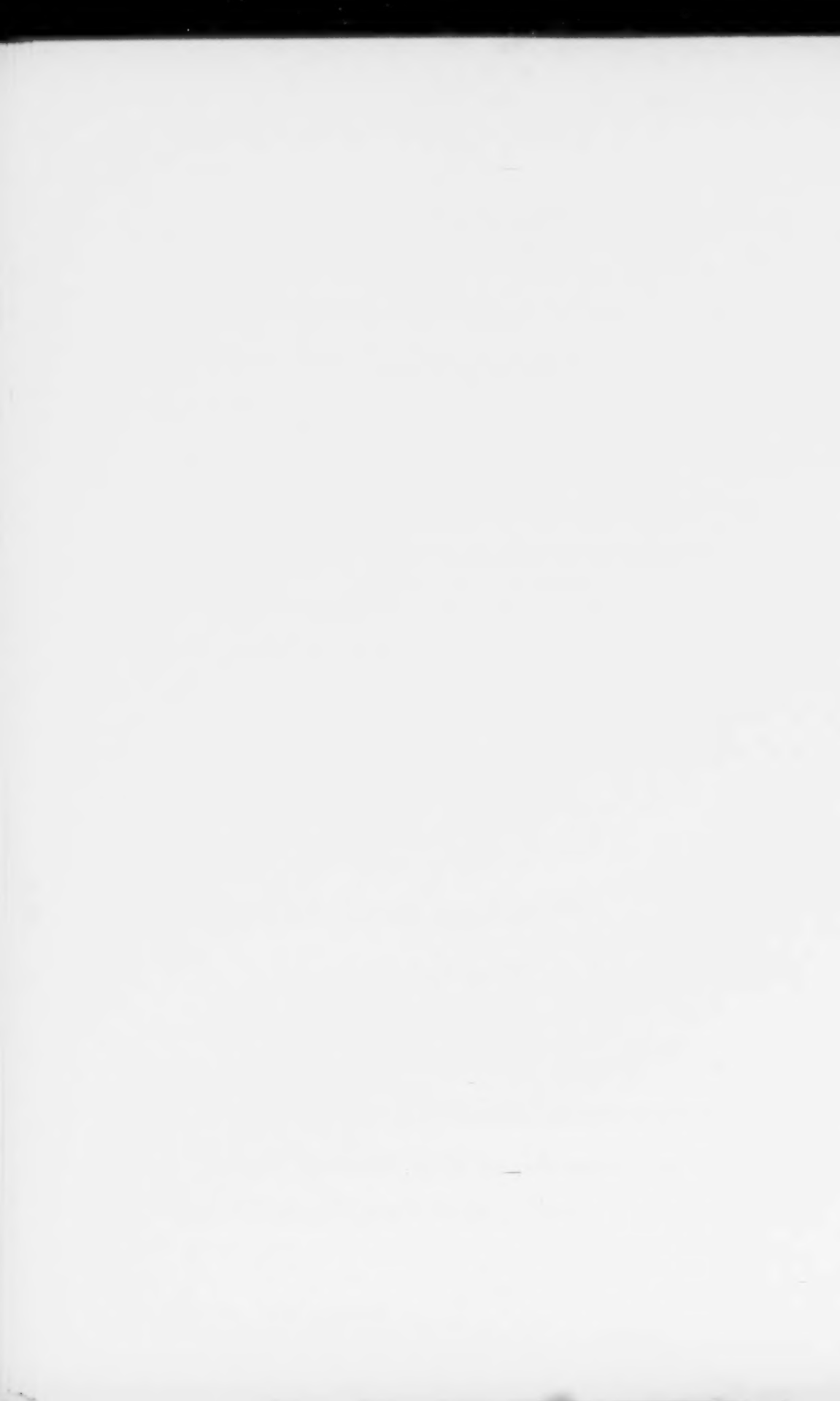
DONALD J. QUIGG, Commissioner of
Patents and Trademarks,

Defendant-Appellee,

DECIDED: July 5, 1989

Before MARKEY, Chief Judge, NEWMAN and MAYER,
Circuit Judges, NEWMAN, Circuit Judge.

Joseph W. Newman, pro se, appeals the judgment of the United States District Court for the District of Columbia, holding unpatentable the invention claimed in Mr. Newman's patent application Serial No. 179,474 entitled "Energy Generation System



Having Higher Energy Output Than Input". Newman v. Quigg, 681 F. Supp. 16, 5 USPQ2d 1880 (D.D.C. 1988). We affirm.

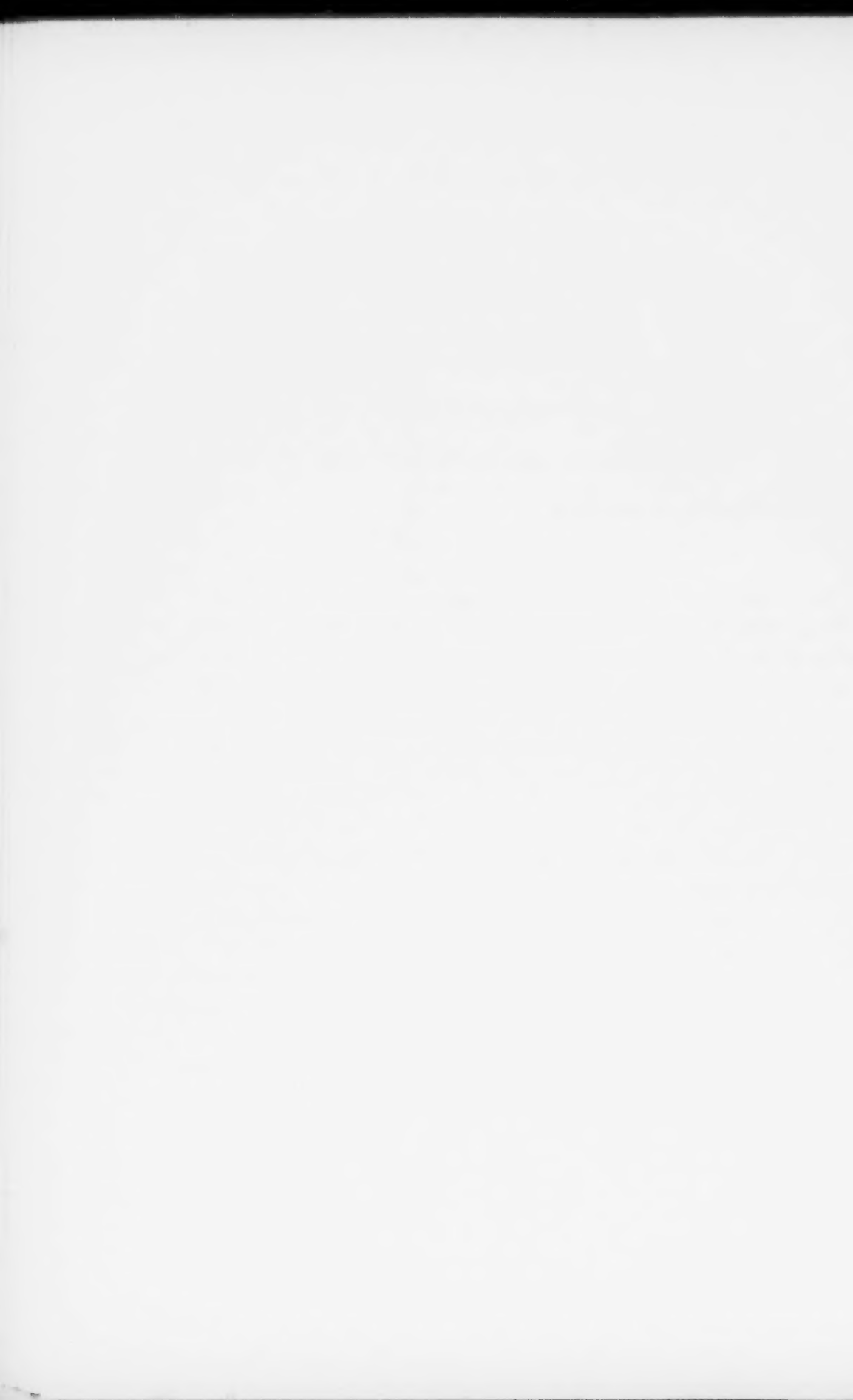
Background

Mr. Newman's application for patent is described by this district court, and we assume general familiarity with that opinion. Claims 38 and 43 are representative of the claims for which Mr. Newman seeks a patent grant:

38. A device which increases the availability of usable electrical energy or usable motion, or both, from a given mass or masses by a device causing a controlled release of, or reaction to, the gyroscopic type energy particles making up or coming from the atoms of the mass or masses, which in turn, by any properly designed system, causes an energy output greater than the energy input.

43. The method of producing usable energy, comprising the following steps:

- a. inputting energy into a device from an external source;
- b. having electrical current flow within said device; and
- c. utilizing the internal electromagnetic energy of at least some of the matter in the device to add to the energy being inputted (sic) into the device from the external source to produce useful energy for use outside of the device having an amount greater than the energy being inputted to the device.



The Patent and Trademark Office ("PTO") Board of Patent Appeals and Interferences affirmed the examiner's rejection of all the claims, i.e., claims 15 through 43, for failure to comply with 35 U.S.C. § 112, first paragraph. The Board held that there was insufficient disclosure to support the claimed result of producing more usable energy output than input. The Board stated that the claimed device was a "perpetual motion machine", and that perpetual motion is impossible for it violates either the first or second law of thermodynamics. During oral argument to the Board Mr. Newman presented a model of his device and demonstrated its operation. The Board does not refer to this demonstration.

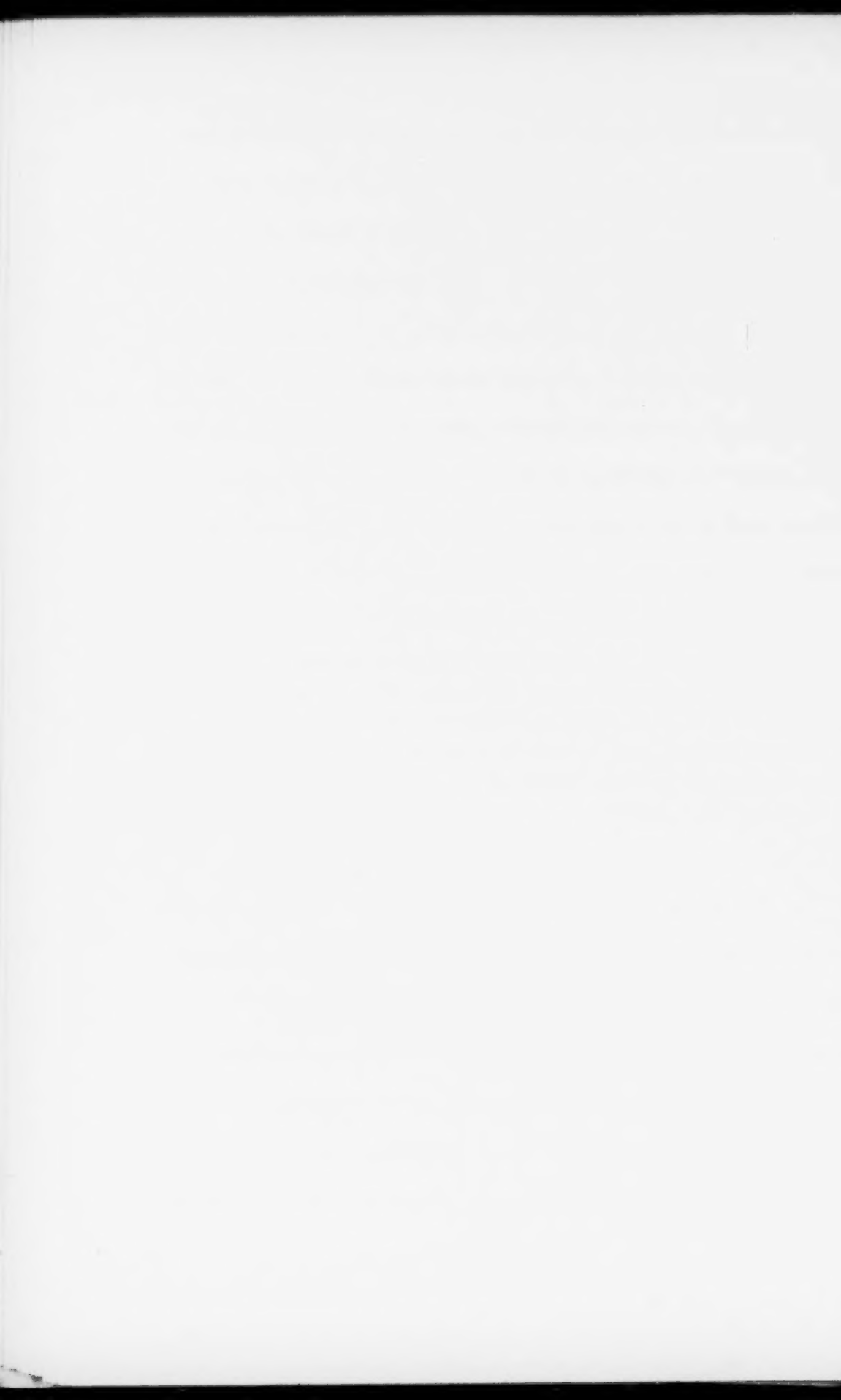
On appeal to the district court, 35 U.S.C., § 145, the court referred the matter to a special master. The evidence before the master included several reports of tests conducted at universities and elsewhere, showing the apparent output of more electric energy than was input by a battery system. A witness, Dr. Hastings, concluded in a pretrial declaration that "(i)t is clear that measured efficiencies for the Newman motor are far in excess of predicted efficiencies. The predicted input power is in agreement with measured input." The evidence also included an affidavit of Mr. J. Rabinow of the National Bureau of Standards, stating his opinion that Mr. Newman's asserted result was "impossible".



The master reported that the results shown for the Newman device appear to conflict with the laws of thermodynamics, and expressed skepticism concerning Mr. Newman's theory of gyroscopic energy and the conversion of mass to energy. The master stated that "(t)here is no evidence corroborating Newman's scientific theory". However, the master also found that the "(e)vidence before the (PTO) and (the district court) is overwhelming that Newman has built and tested a prototype of his invention in which the output energy exceeds the external input energy; there is no contradictory factual evidence". The master concluded that

Even though the operation of Plaintiff's system seems contrary to recognized scientific principles, Plaintiff has demonstrated the operation of his system by very clear evidence and is therefore entitled to a patent if he otherwise satisfies the requirements of the Patent Statute (35 USC). In re Chilowsky, 229 F.2d 457 (CCPA 1956).

Before the district court, the Commissioner strongly objected to the master's report. The district court ordered, as recommended by the master and requested by the Commissioner, that the application be referred back to the PTO for review by a different patent examiner. The court also ordered, as recommended by the master, that the claims thus reviewed be those in a Rule 116 amendment that had previously been refused entry. This amendment



made changes in the claims that had been on appeal to the Board, amending all the claims except claims 38 and 43.

The second examiner entered the Rule 116 amendment and rejected all the claims for failure to comply with 35 U.S.C. §§ 101, 102, 103 and 112. The examiner ordered Mr. Newman, pursuant to 35 U.S.C. § 114, to submit working models of three embodiments of his invention, based on three drawings in the specification, to the National Bureau of Standards ("NBS") for testing, under penalty of abandonment. Mr. Newman sought relief from this requirement and its penalty, which reached this court by mandamus petition. Mr. Newman pointed out that he had demonstrated a working model to the Board, had invited observation by the PTO of additional demonstrations, and that this new demand for working models was burdensome and unnecessary.

This court held the requested relief to be unnecessary:

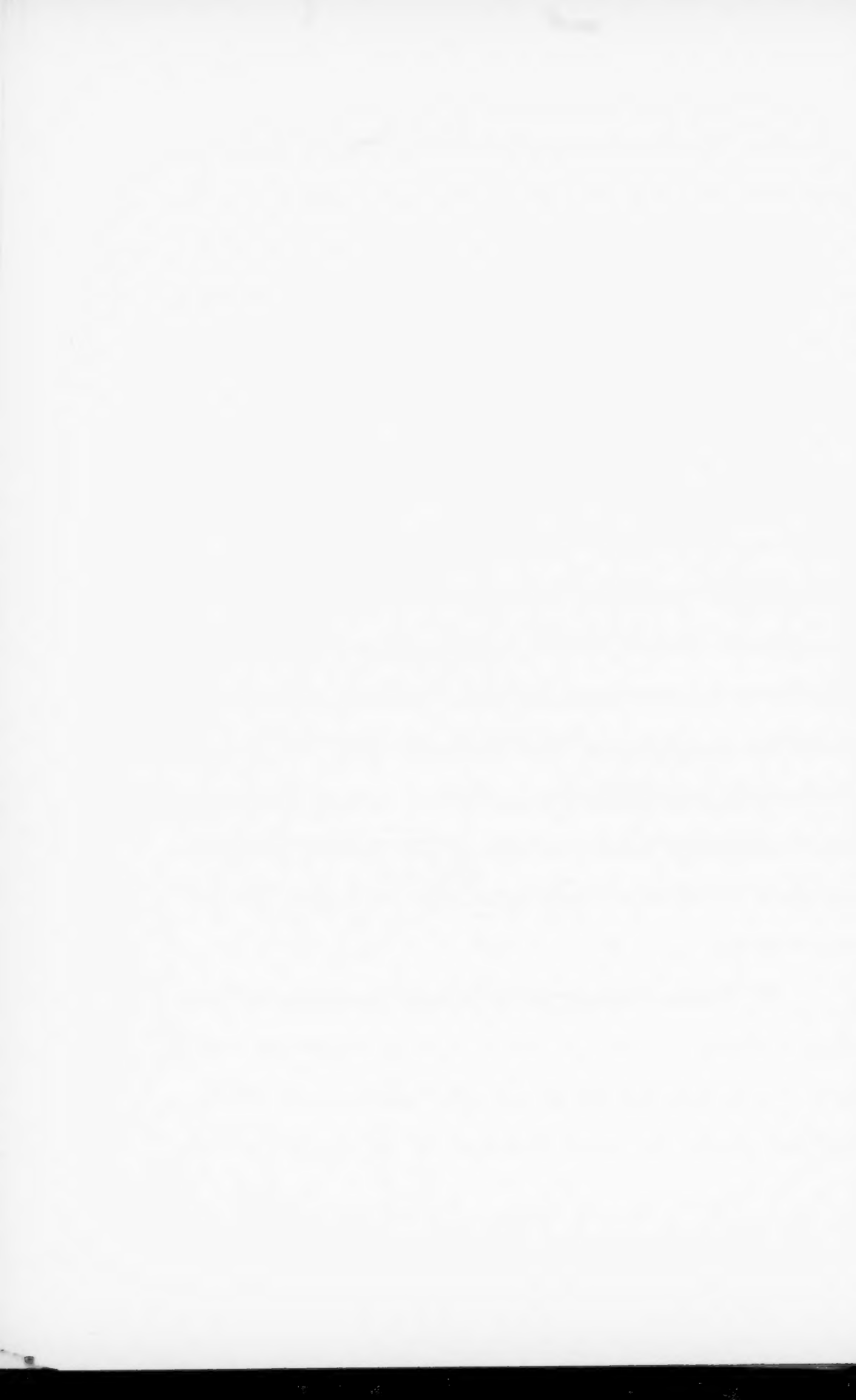
Newman has pending in the district court a § 145 action from which an appeal to this court will lie, whether the PTO does or does not treat his application as abandoned. Thus, the PTO's threat (of abandonment) does not require issuance of the writ to aid or preserve our prospective appellate jurisdiction, (or the jurisdiction of the district court). In re Makari, 708 F.2d 709, 218 USPQ 193 (Fed. Cir. 1983).



In re Newman, 763 F.2d 407, 410, 226 USPQ 97, 99 (Fed. Cir. 1985). This court thus held that a PTO holding of abandonment under these circumstances could not deprive the courts of jurisdiction. In all events, Mr. Newman did not comply with the examiner's order within the time period set by the examiner, and the examiner declared the patent application abandoned.

The district court had followed, through periodic status conferences, these proceedings before the second examiner. When this phase was ended by the examiner's declaration of abandonment, at the district court's suggestion the Commissioner ordered Mr. Newman under Fed. R. Civ. P. 34 to produce a model of his invention for testing by NBS. The Commissioner's order, as modified by the district court and by this court on petition for writ of mandamus, In re Newman, 782 F.2d 971, 228 USPQ 450 (Fed. Cir. 1986), reh'g denied mem. (Fed. 12, 1986), in essence required that a normal inter partes test be conducted at NBS, and that the tests be completed and the report issued within thirty days after the device was produced.

Mr. Newman produced a model of his invention within the fourteen days set by the court. After almost two months the district court, at a status conference, gave Mr. Newman's counsel NBS's proposed protocol for testing the device, ordered the NBS to



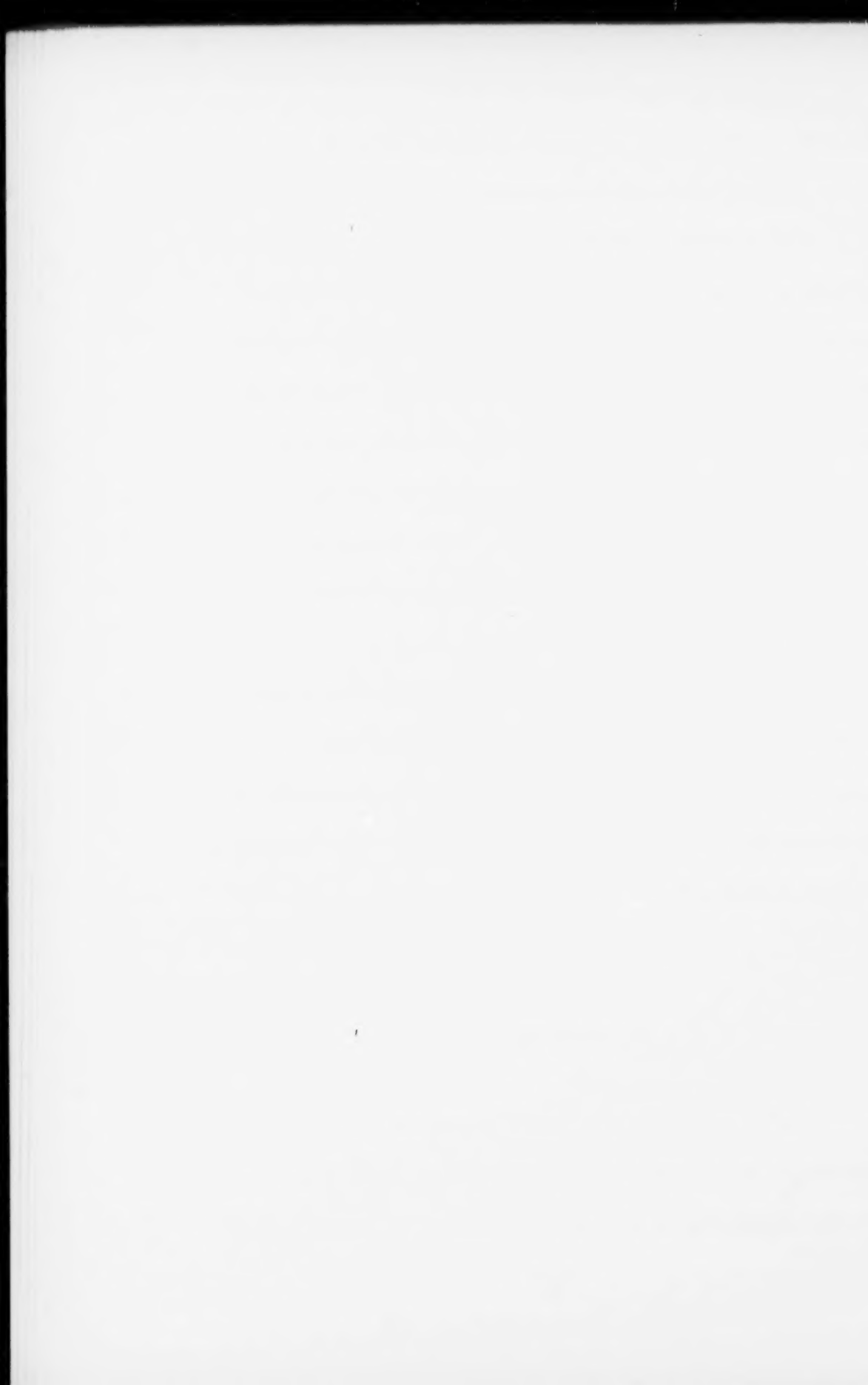
commence testing, and granted an extension as requested by the Commissioner to allow NBS to complete the testing.

NBS received no response on Mr. Newman's behalf to the proposed test protocol. The record states that there were two observations of tests on behalf of the Commissioner, and none on behalf of Mr. Newman. The NBS report, issued five months after delivery of the device, concluded that the device did not produce more energy output than input, and that it showed efficiency measured at between 27 and 77 percent. At the subsequent trial the district court held the claimed invention unpatentable for noncompliance with 35 U.S.C. §§ 101 and 112.

On this appeal Mr. Newman asserts that the district court clearly erred in rejecting the findings of the special master, and that reversal of that error would moot all subsequent proceedings. He also argues that the NBS did not conduct a proper or fair inter partes test, and that patentability is supported by the heavy weight of the evidence.

Jurisdiction

The Commissioner asserts that the judgment of the district court should be vacated for lack of jurisdiction, on the ground that the patent application became abandoned when, during the referred

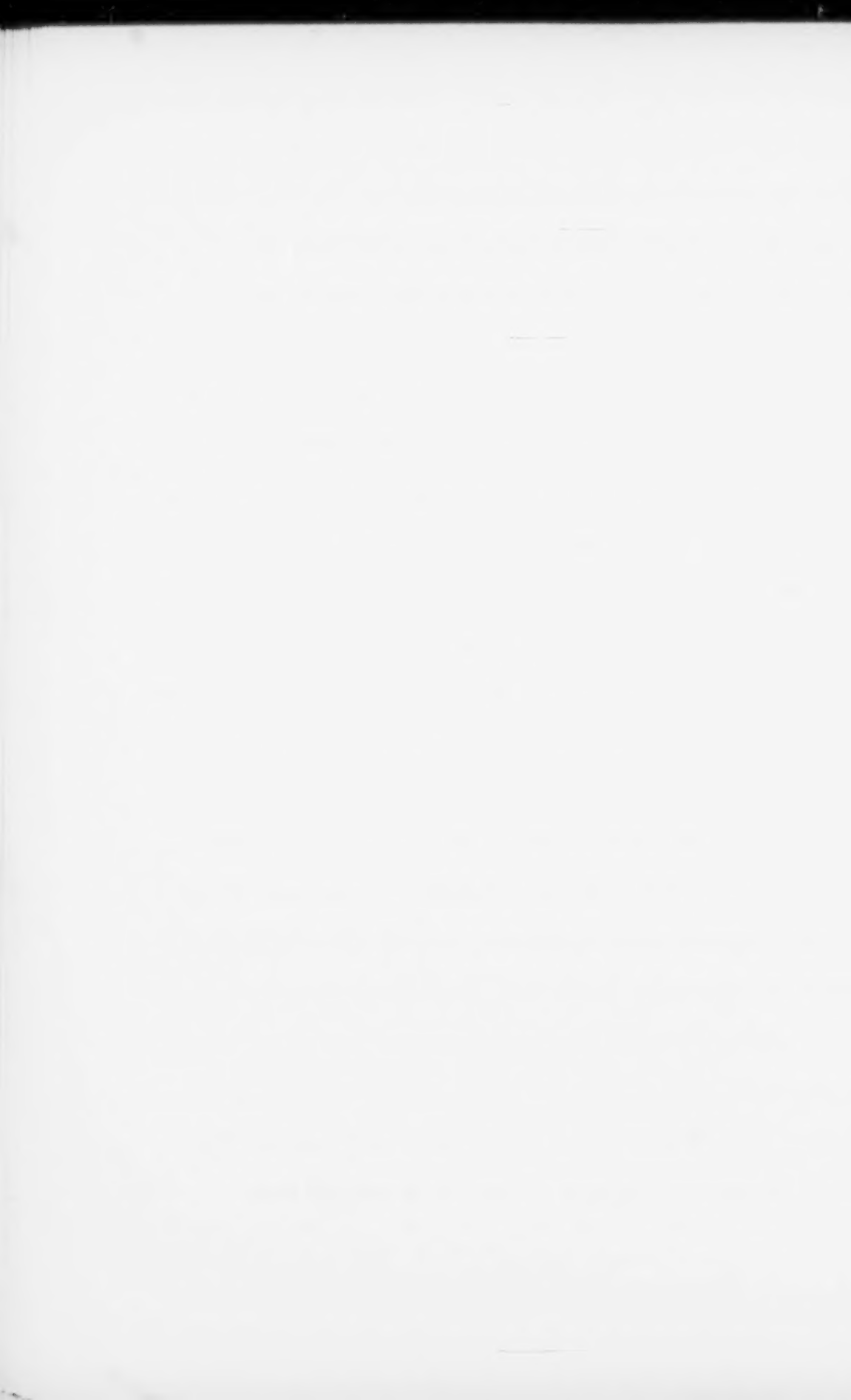


to the PTO by the district court, Mr. Newman did not produce three working models as the second examiner ordered. The Commissioner argues that the district court lost jurisdiction over Newman's application when the application was held abandoned by the examiner.

We settled this issue in 1985 in In re Newman, 763 F.2d at 410, 226 USPQ at 99, wherein we held, as quoted supra, that "the PTO's threat (of abandonment) does not require issuance of the writ to aid or preserve our prospective appellate jurisdiction, (or the jurisdiction of the district court)." That holding was and is the law of the case. The examiner's order of abandonment could not unilaterally extinguish the court's jurisdiction over the pending § 145 action, and the district court correctly declined to terminate its proceeding.

The Commissioner argues, alternatively, that even if the district court had that jurisdiction it extended only to claims 38 and 43, and judgment would be vacated as to all the other claims, on the theory that all the other claims were not properly before the court.

Claims 38 and 43 were the only claims that were not amended in the Rule 116 amendment that was ordered by the district court to be the basis of examination by the second examiner. The second examiner having rejected these claims and held them

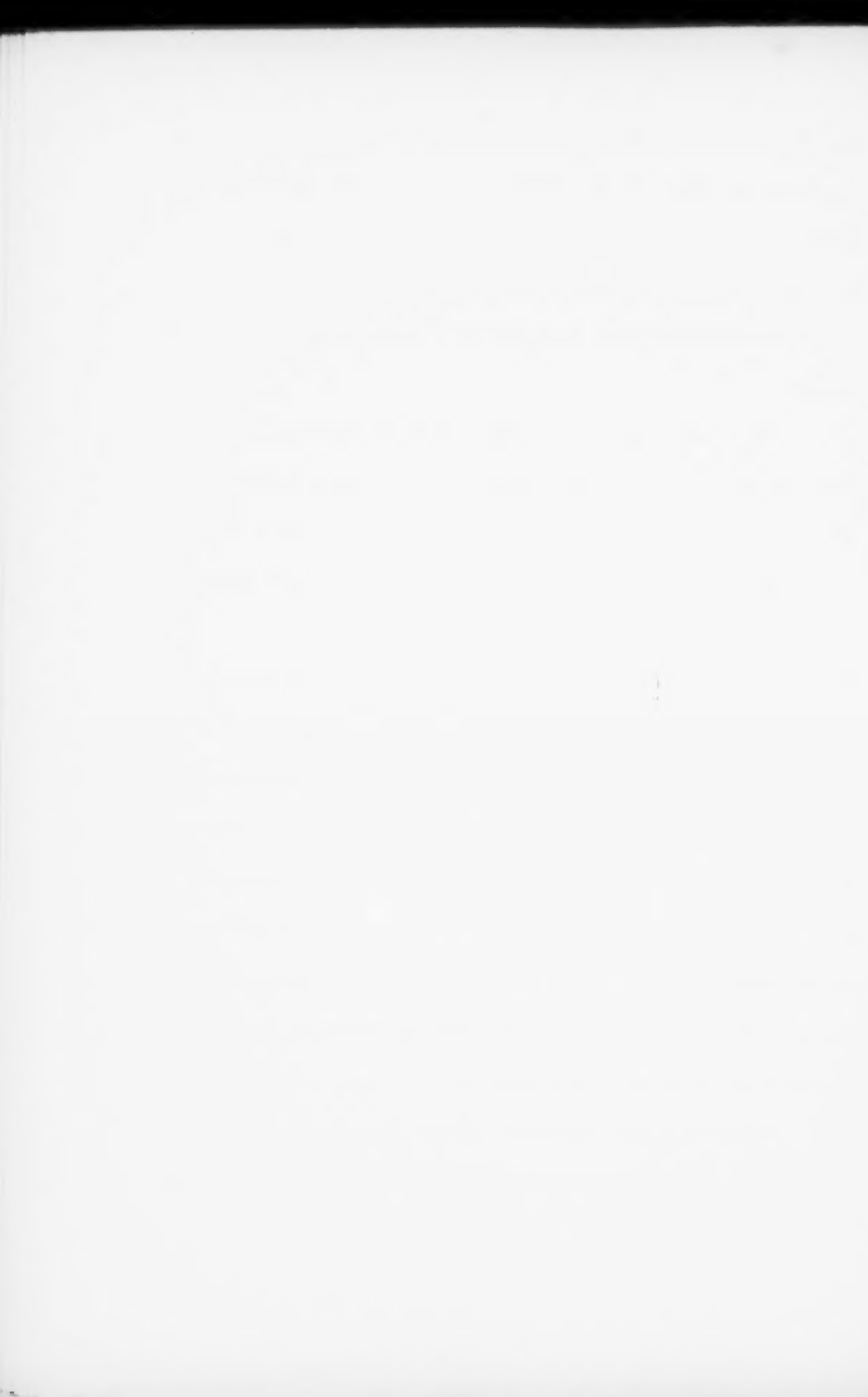


abandoned, the Commissioner argues that Mr. Newman was required to proceed by certain internal PTO procedures in order to preserve these amended claims for judicial review, such as the filing of a petition to the Commissioner protesting the examiner's ruling of abandonment, followed by an appeal to the court if that petition were denied.

The Commission further states that the prior claims, the Board's rejection of which was the basis for the appeal as filed under 35 U.S.C. § 145, also were no longer before the district court except for claims 38 and 43, because all the other claims were amended when the district court ordered further examination under the master's report. That is, the claims in their forms both before and after entry of this Rule 116 amendment had lost the right or opportunity for judicial review, according to the Commissioner.

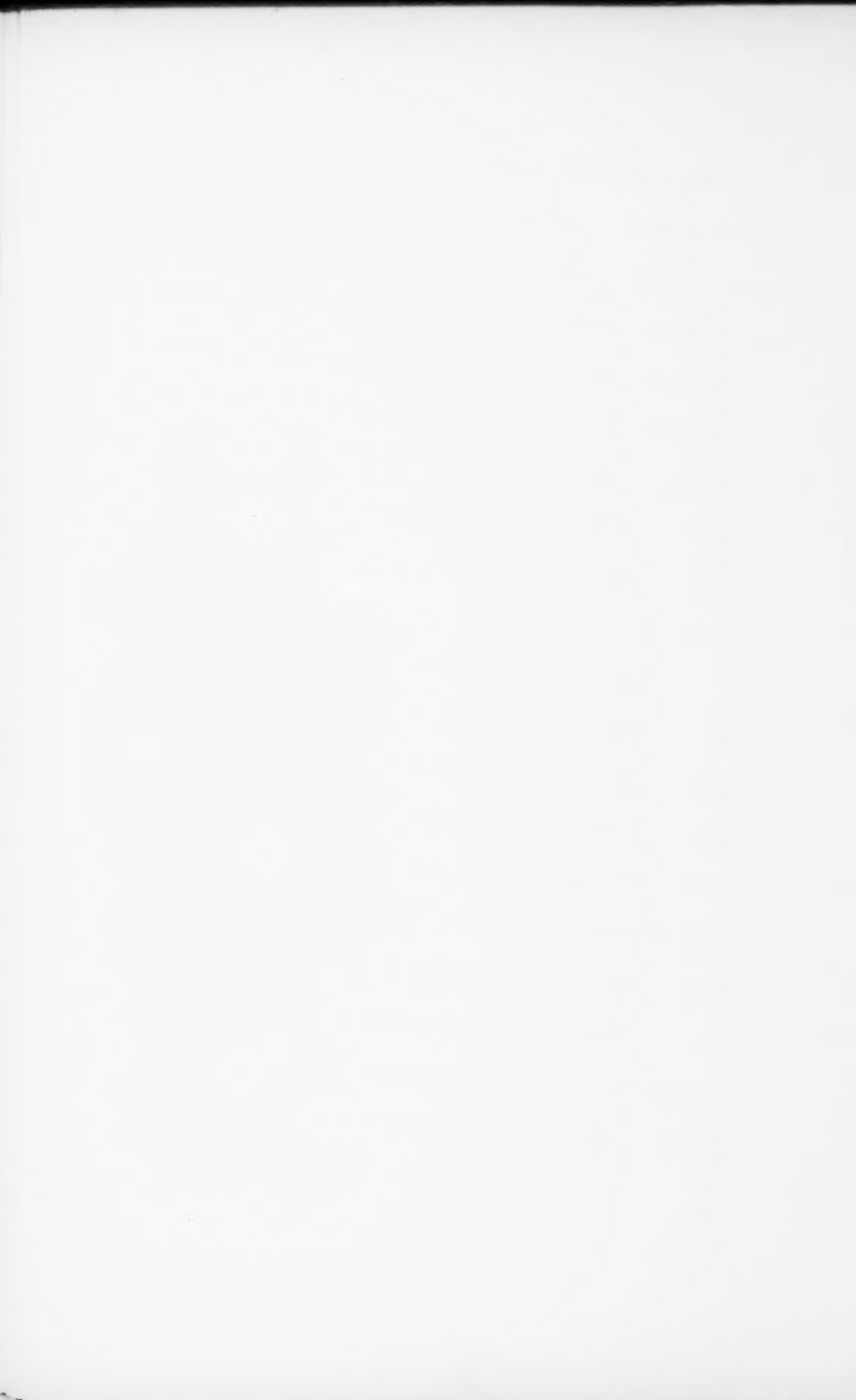
We do not agree with this creative theory. The district court had authority to refer the application to the PTO for designated purposes, including that a second examiner review the claims in certain amended form. As we held in 1985, see In re Newman, supra, the Commissioner has no authority unilaterally to remove claims from the jurisdiction of the court.

While the Board will normally have decided every issue that is raised before the district court, as discussed in Rendleman v. Ladd,



197 F. Supp. 304, 309, 130 USPQ 300, 304 (D.D.C. 1961), the court is not required to obtain, or suspend all proceedings while the applicant obtains a full administrative Board decision for every fresh aspect that arises during the course of the judicial proceeding. Otherwise, the Commissioner could not have added a ground of rejection, 35 U.S.C. § 101, that was not before the Board. See generally DeSeversky v. Brenner, 424 F.2d 857, 858, 164 USPQ 495, 496-97 (D.C. Cir. 1970) (It is generally improper to raise new issues in a § 145 action, on the principle of exhaustion of administrative remedies).

A district court action under 35 U.S.C. § 145 is a de novo determination of patentability. It is not limited to the record before the PTO. Gould v. Quigg, 822 F.2d 1074, 1076-77, 3 USPQ 2d 1302, 1303 (Fed. Cir. 1987); Fregeau v. Mossinghoff, 776 F.2d 1034, 1037, 227 USPQ 848, 850 (Fed. Cir. 1985). Unless a party prejudiced thereby or due process is denied, expeditious justice is better served by avoiding artificial restrictions on the district court's authority to resolve all issues reasonably raised in this proceeding. See generally Burlington Industries, Inc. v. Quigg, 822 F.2d 158, 1584, 3 USPQ 2d 1436, 1439 (Fed. Cir. 1987).



The Report of the Special Master

Mr. Newman argues that the district court should not have rejected the recommended findings and conclusions of the special master. Appellate review of the correctness of the district court's action in turn requires determination of whether the master's findings are or are not clearly erroneous. Fed. R. Civ. P. 53(e) (2); Milliken Research Corp. v. Dan River, Inc., 739 F.2d 587, 593, 222 USPQ 571, 576 (Fed. Cir. 1984).

The district court held the master's report to be "clearly erroneous in that it apparently contradicts the first law of thermodynamics" — an apparent contradiction that had been referred to by the master. This court, like the master and the district court, believes that the laws of thermodynamics do not brook contradiction. However, the laws of thermodynamics do not require closing of either the scientific or the judicial mind to the possibility that the phenomena manifested can be explained by theories that do not violate inviolable scientific principles. The master so recognized, even as he expressed strong skepticism about Mr. Newman's scientific theory of harnessing gyroscopic of electromagnetic energy. But when the court-ordered test did not verify the results claimed by Mr. Newman, the matter of the scientific explanation of the claimed results became moot.

Taking notice of the unusual nature of Mr. Newman's asserted technological results and proffered explanation, we discern no error in the district court's decision to decline to adopt the recommended conclusion of the special master, and instead to order further examination by the PTO, followed by the order that a test of performance of the Newman device be conducted by the NBS.

The NBS Tests

Mr. Newman asserts that the NBS testing procedure was flawed and generally unfair, and that the district court did not adhere to the conditions set in In re Newman, 782 F.2d at 975, 228 USPQ at 453. Mr. Newman points out that NBS took five months after he delivered the device, and that NBS routinely failed to provide sufficient notice to enable him to attend the tests.

This court had declined to intervene in the district court's grants, at the Commissioner's request, of extensions of time for the NBS tests. In re Newman, Misc. NO. 105 (Fed. Cir. March 19, 1986). However, the record shows none of the usual comity of inter partes * test procedures. Neither the NBS nor the PTO is shown to

* For example, the NBS wrote to the PTO Solicitor: "We will not deal directly with the inventor or his representatives. We are referring all contacts to you in the PTO." Nor was Mr. Newman cooperative. When a NBS engineer asked Newman, who was installing the device at NBS, to identify the output, Newman's counsel directed him not to answer, instead directing the NBS to certain pages in Newman's book.



have made reasonable efforts to consider the convenience of Newman of his counsel.

Mr. Newman argues that the NBS evaluation was fatally defective because all tests were conducted with the device grounded. He states that it is essential that his device not be grounded during operation. He points to two reports from Mississippi State University which were provided to NBS; one report showed deficiencies below 100% when the device was grounded, and the other contained comments by one of the Mississippi State engineers that efficiencies greater than 100% appeared to be obtained when the device was not grounded. It is undisputed that NBS had copies of these reports prior to designing its tests. Mr. Newman argues that had NBS sought to duplicate or verify any of these test results reported by others, NBS would have discovered its errors. Newman argues that NBS should have done this in order to confirm or deny his claims.

The Commissioner defends the NBS procedure, arguing that grounding the device did not account for the lower efficiencies observed by NBS. The NBS engineer who designed and conducted the tests testified that his ground would not have affected radio frequency, referring to a theory of one of Mr. Newman's witnesses of how the device worked. But no witness for the NBS or the PTO

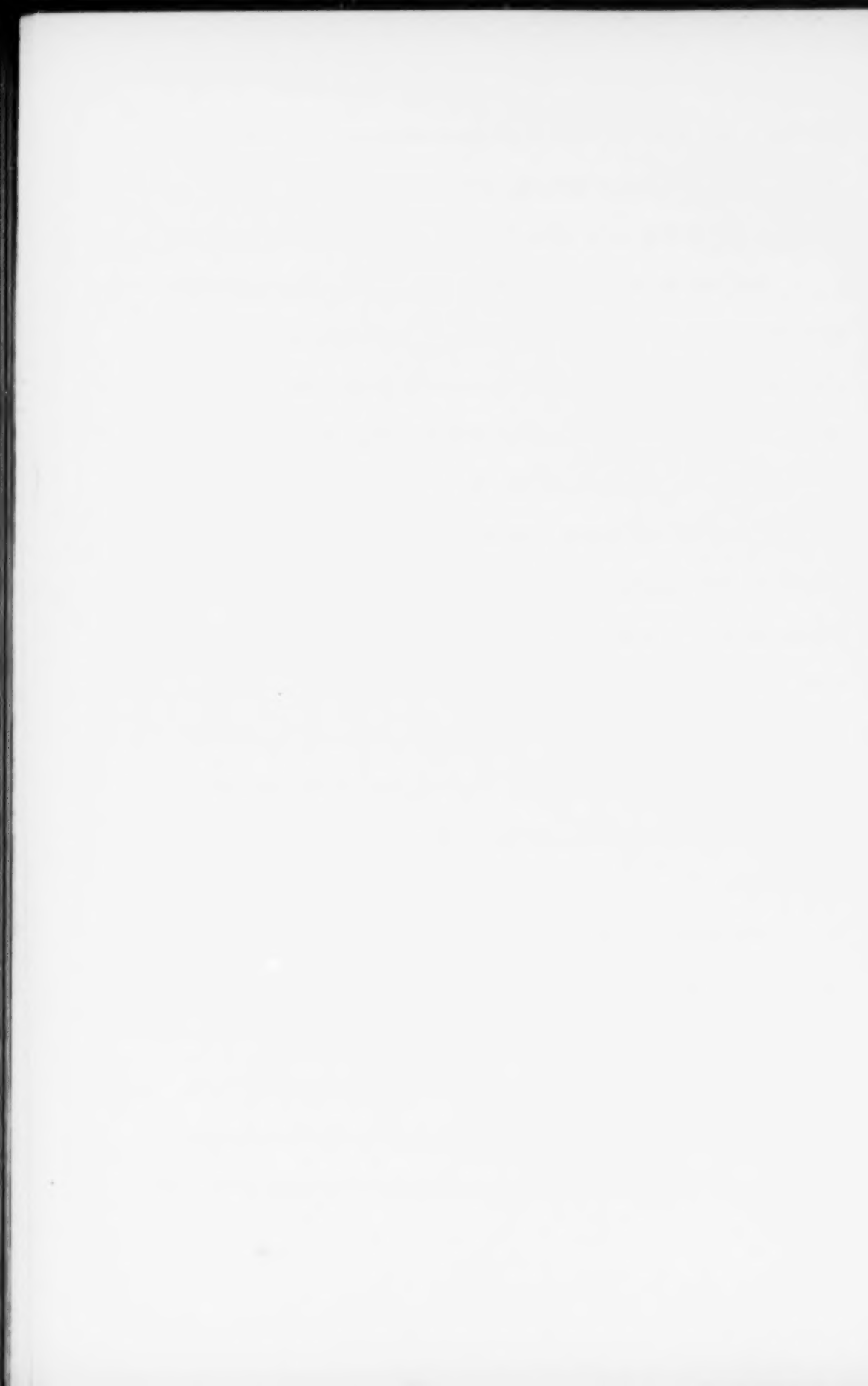


testified as to performance with all grounding removed. The district court, hearing testimony and argument on these points, held that the NBS test procedures were appropriate, and their results dispositive.

We need not decide whether the NBS tests were conducted by a flawed procedure, for any flaw could have been, and was not, corrected by Mr. Newman at the time of the tests. The test protocol designed by NBS contained electrical schematics showing plainly that the device was grounded. Mr. Newman does not dispute that he had a copy of the test protocol before testing began. The record shows no communication or objection. The Commissioner further points out that the patent specification does not mention the need to avoid grounding the device.

Similarly, Mr. Newman now objects to the use by NBS of load resistors connected in parallel with the coil to measure the output. This too was shown in the pre-test plan, and was not objected to.

We conclude that Mr. Newman had a duty to raise objection, before or during testing, to any defects in the test protocol that he knew or believed would impair the results. He had a clear chance to obtain a definitive test, and to the extent that he did not take it, he can not now impeach the results that were conducted by procedures of which he had advance knowledge. If there were flaws in the NBS



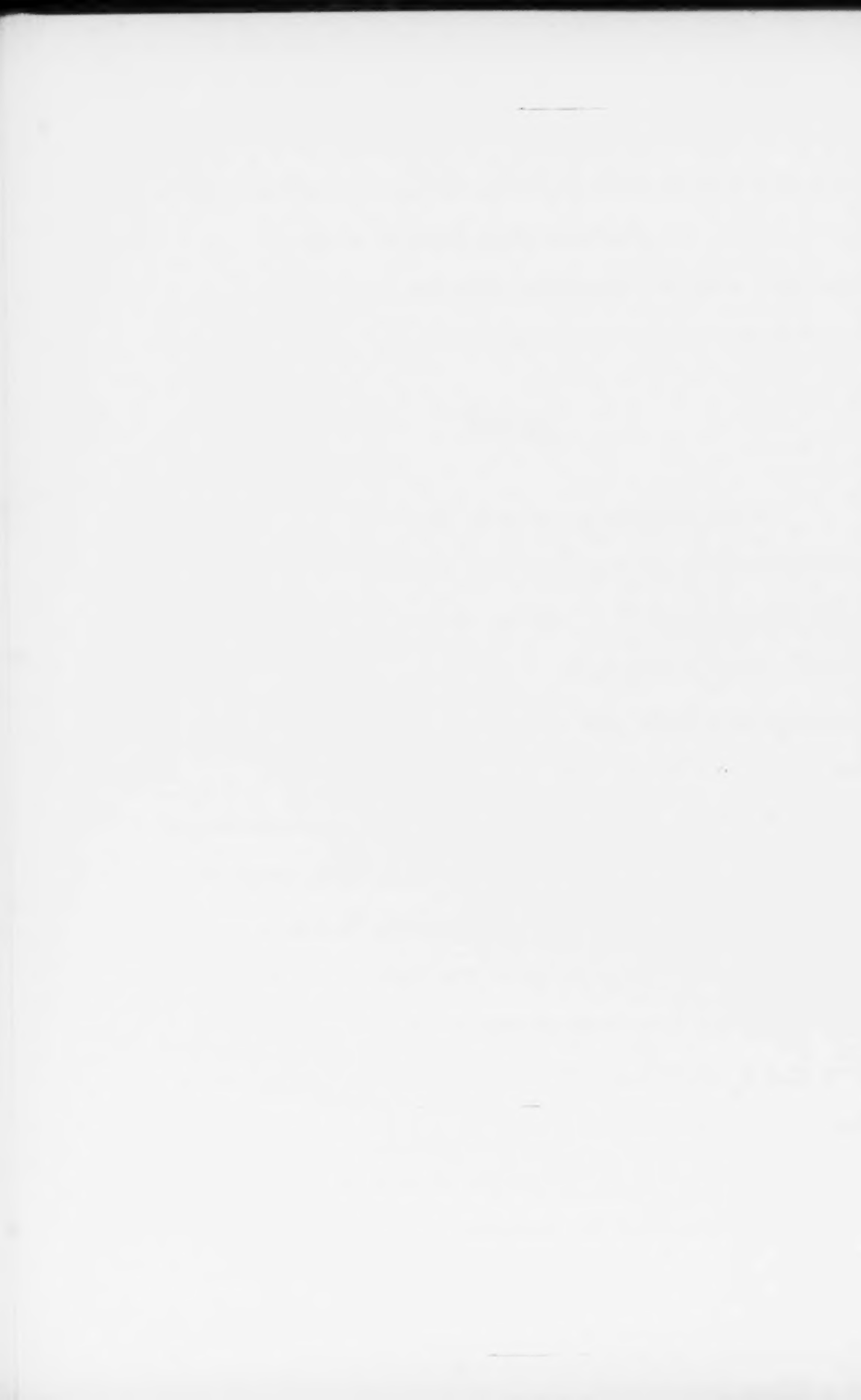
protocol, we do not now give controlling weight to objections that could have been raised at a time when any errors could have readily been corrected. We conclude that Mr. Newman waived or acquiesced in any purported defect in the test procedure by remaining silent throughout the test period.

The Trial

The district court, on trial of the merits, held Mr. Newman's invention unpatentable under 35 U.S.C. § 101 because "Newman's device lacks utility (in that it does not operate to produce what he claims it does)". Utility under 35 U.S.C. § 101 is a question of fact. Raytheon Co. v. Roper Corp., 724 F.2d 951, 956, 220 USPQ 592, 596 (Fed. Circ. 1983), cert. denied, 469 U.S. 835 (1984).

Mr. Newman argues that the district court gave undue weight to the NBS test results, and failed to accord proper and overriding weight to the testimony and affidavits supporting the claimed increase in energy output. The district court acknowledged that it must consider all of the evidence presented at the de novo proceeding in reaching an independent conclusion. Newman, 681 F. Supp. at 22-23, 5 USPQ 2d at 1885.

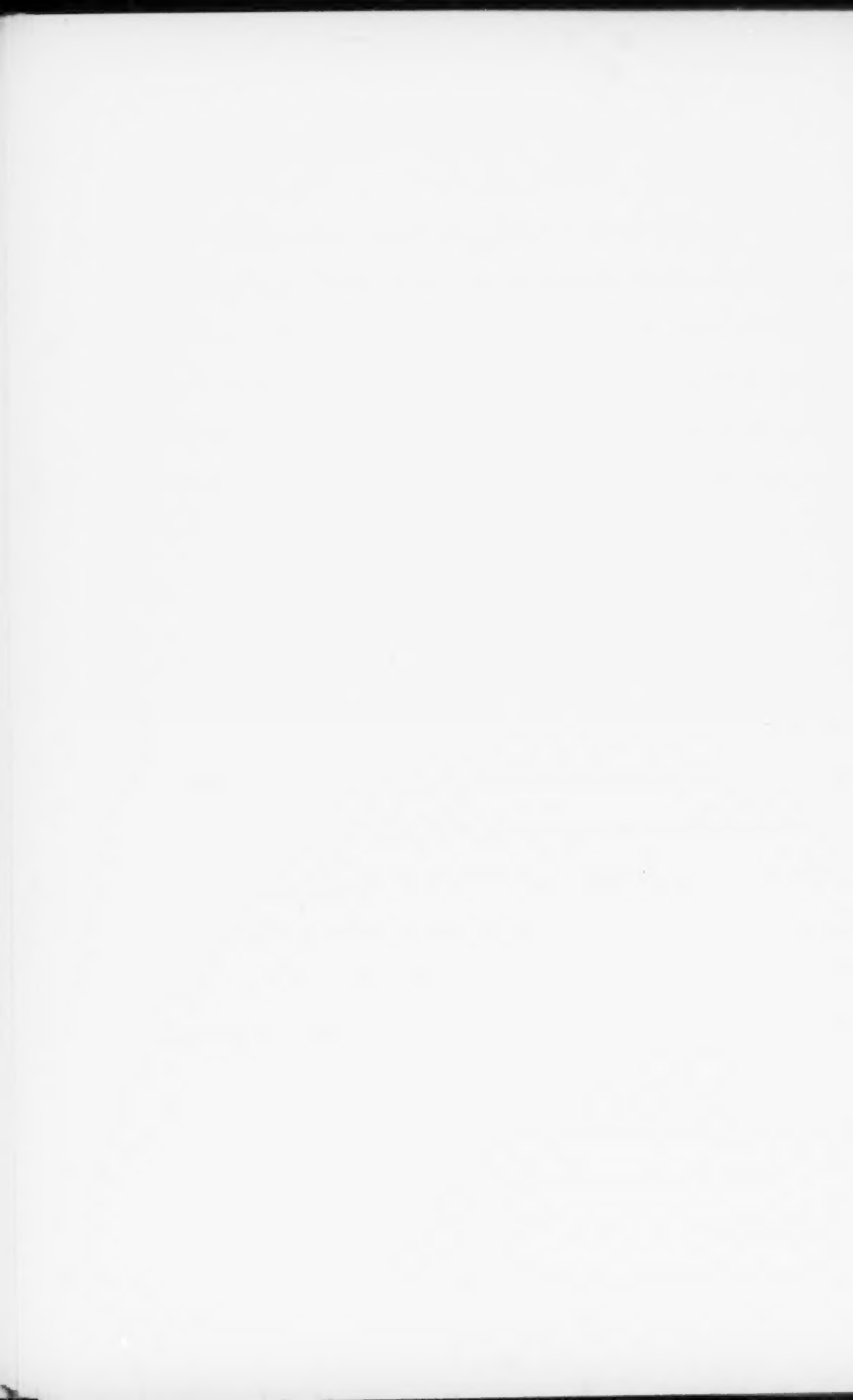
The court described the evidence on Newman's behalf as "largely qualitative rather than quantified by measured data" id. at



5 USPQ 2d at 1883, while "credit(ing) in full the meticulously thorough and well-documented testing done by NBS". Id. at 23, 5 USPQ 2d at 1886. The court remarked that at best Mr. Newman's evidence showed prolonged operation on dry cell batteries, but that "such a device is not the one for which Newman seeks a patent." Id. We discern no error in the district court's analysis, and conclude that the court did not clearly err in giving controlling weight to the NBS report and in concluding that the utility claimed for Newman's device had not been demonstrated.

Mr. Newman also argues that the district court incorrectly held that his application was not enabling under 35 U.S.C. § 112, first paragraph. He asserts that his claims are adequately supported by, and the invention enabled by, the disclosure. Enablement under 35 U.S.C. § 112 is deemed to be a question of law, Allen Organ Co., v. Kimball Int'l. Inc., 839 F.2d 1556, 1566, 5 USPQ 2d 1769, 1777 (Fed. Cir.), cert. denied, 109 S. Ct. 132 (1988); although it is apparent that lack of utility because of inoperativeness, and absence of enablement, are closely related grounds of unpatentability. Raytheon Co., 724 F.2d at 956, 220 USPQ at 596.

While it is not a requirement of patentability that an inventor correctly set forth, or even know, how or why the invention works, Diamond Rubber Co. v. Consolidated Rubber Tire Co., 220 U.S.



428, 435-36 (1911); Fromson v. Advance Offset Plate, Inc., 720 F.2d 1565, 1570, 219 USPQ 1137, 1140 (Fed. Cir. 1983), neither is the patent applicant relieved of the requirement of teaching how to achieve the claimed result, even if the theory of operation is not correctly explained or even understood. In re Isaacs, 347 F.2d 887, 892, 146 USPQ 193, 197 (CCPA 1965); In re Chilowsky, 229 F.2d 457, 463, 108 USPQ 321, 326 (CCPA 1956).

The district court held that Mr. Newman's claimed device and method do not produce the claimed result, following the teachings of the specification. We affirm the conclusion that the requirements of 35 U.S.C. § 112, first paragraph, are not met.

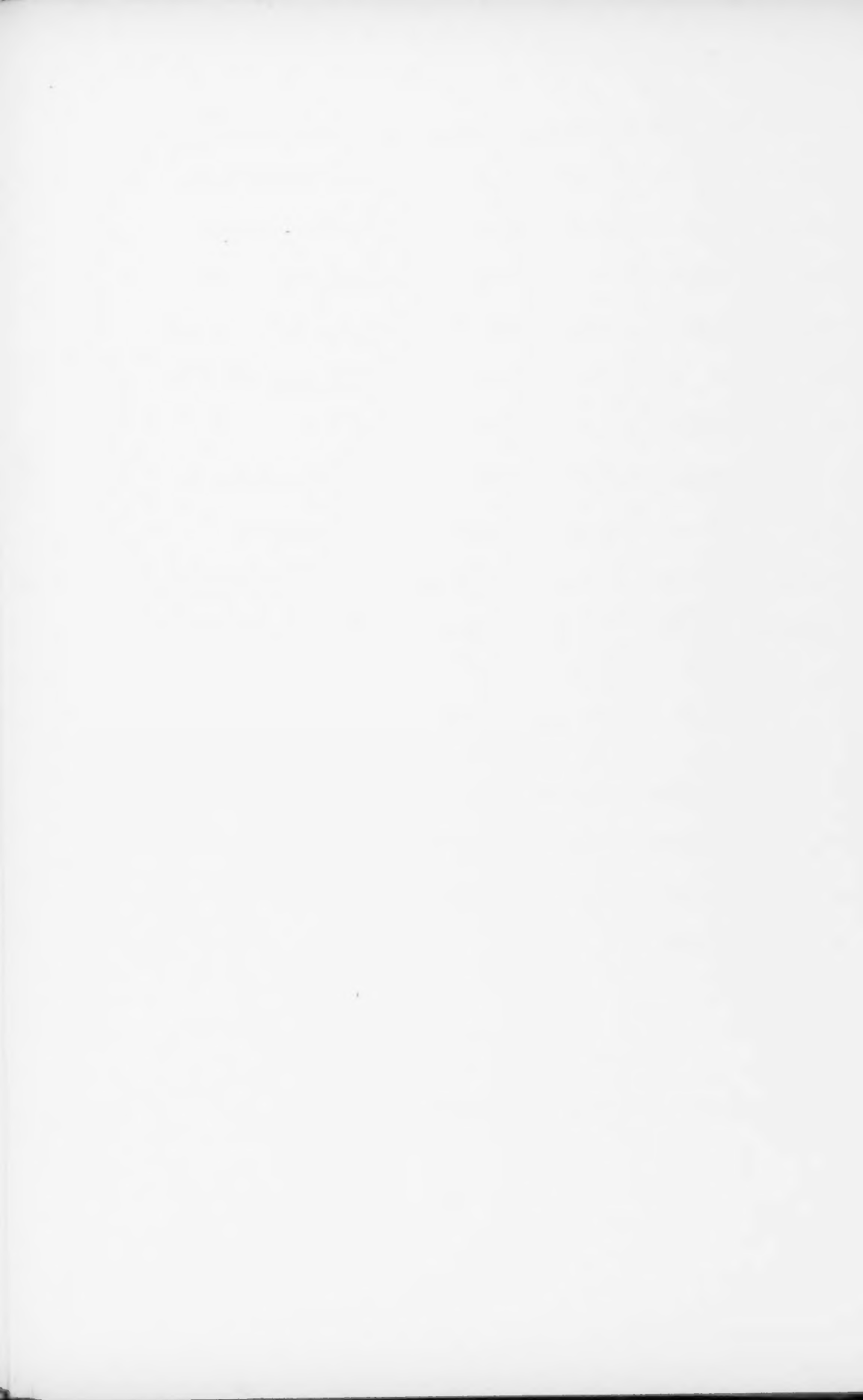
Conclusion

The decision of the district court that the claimed invention is unpatentable because it fails to comply with 35 U.S.C. § 101 for lack of utility, and with 35 U.S.C. § 112, first paragraph, for lack of enablement, is affirmed.

Costs

Each party shall bear its own costs.

AFFIRMED



APPENDIX B

United States Court of Appeals for the Federal Circuit

88-1312

JOSEPH W. NEWMAN,

Plaintiff-Appellant,

v.

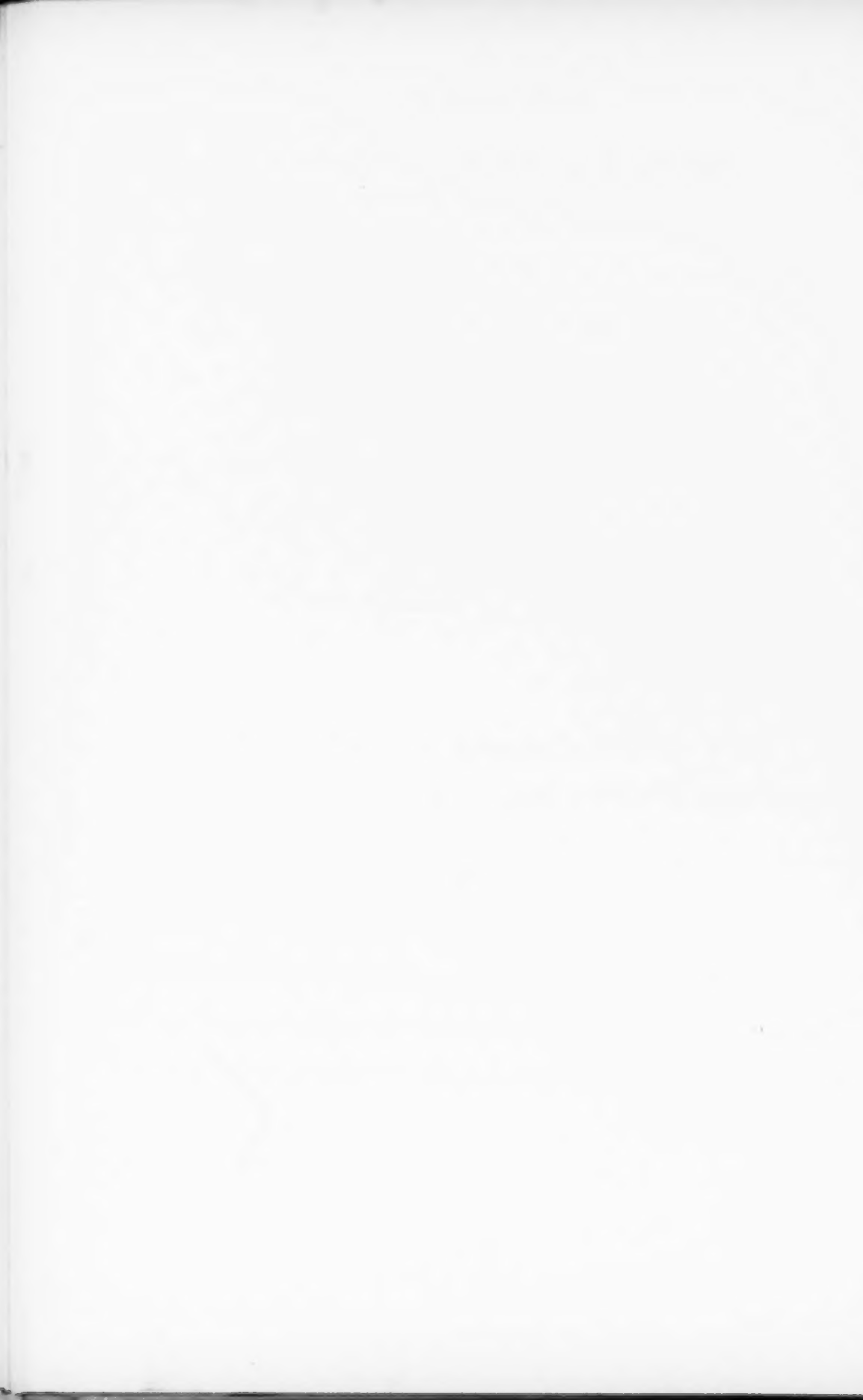
DONALD J. QUIGG, Commissioner of
Patents and Trademarks,

Defendant-Appellee,

Before MARKEY, Chief Judge, NEWMAN and MAYER,
Circuit Judges, NEWMAN, Circuit Judge.

ORDER

At the Commissioner's request, the court has considered the application of 35 U.S.C. § 145 to the assessment of the costs of the appeal Newman v. Quigg, 877 F.2d 1575, 11 USPQ 2d 1340 (Fed. Cir. 1989).



Mr. Newman had filed a sparse Appendix; the Commissioner moved for permission to file a supplemental appendix, and duly filed nine volumes thereof. As Mr. Newman points out, the Commissioner's appendix included material in violation of Fed. Cir. R. 30 (a) (2) and 30 (b). In light of all the circumstances, it is inappropriate to tax Mr. Newman with the costs of the Commissioner's Appendix. Fed. R. App. P. 30 (b).

Accordingly, IT IS ORDERED THAT:

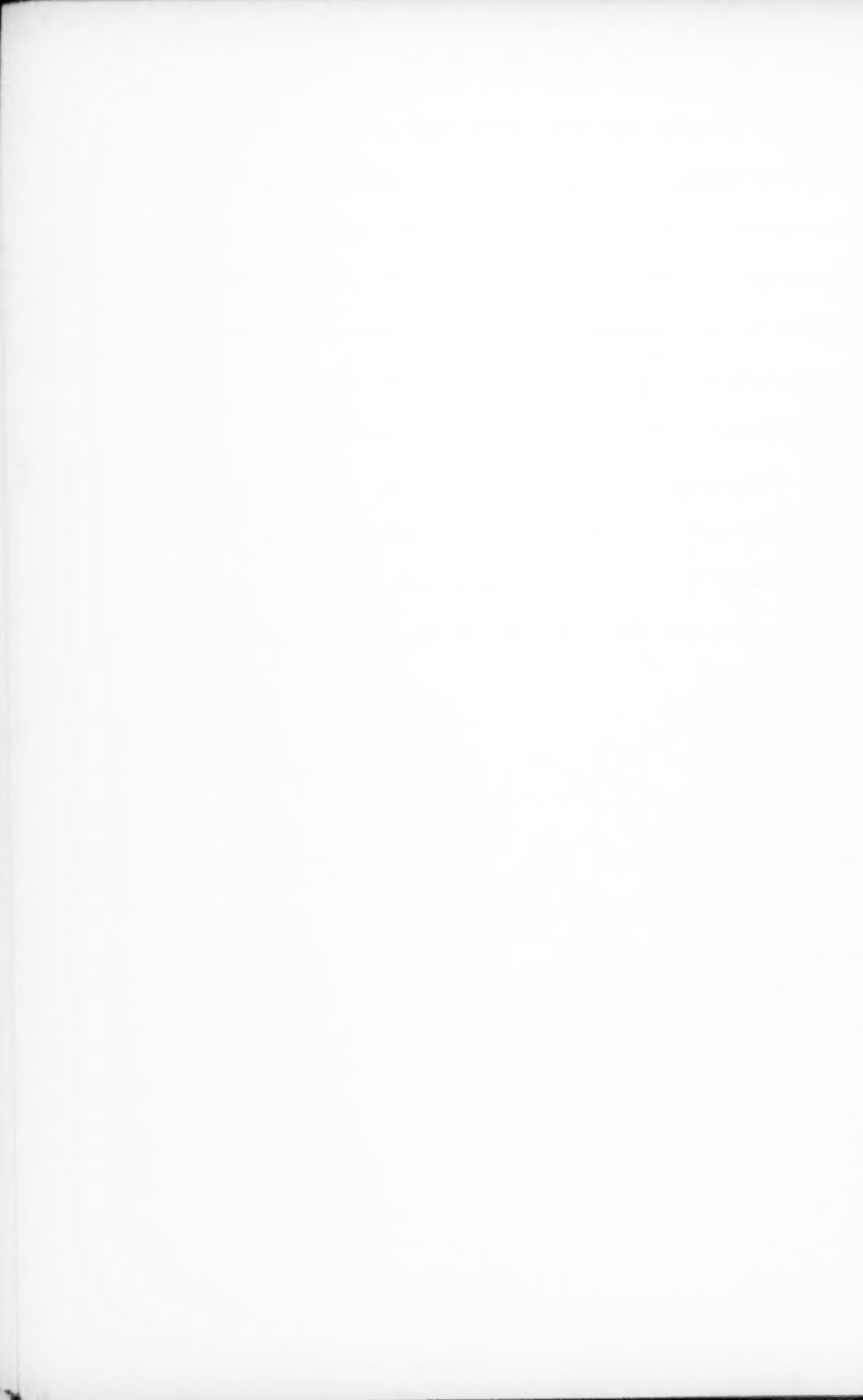
The court's judgment of July 5, 1989 is modified to the extent that Mr. Newman shall pay the taxable costs of this appeal except for the costs attributed to the Commissioner's Appendix.

FOR THE COURT

Date

Pauline Newman
Circuit Judge

cc: Joseph W. Newman, Esq.
Fred E. McKelvey, Esq.



APPENDIX C

United States Court of Appeals for the District of Columbia

JOSEPH W. NEWMAN,)

Plaintiff,)

v.)

Civil Action No.

83-0001

DONALD J. QUIGG,)

Commissioner of)
Patents and Trademarks,)

Judge JACKSON

Defendant,)

JUDGMENT FOR EXPENSES

This matter having been tried by the Court, and the Court having entered a judgment on the merits in favor of defendant on February 17, 1988, the U.S. Court of Appeals having affirmed the judgment, and upon consideration of defendant's request for expenses, the parties having been heard, it is

ORDERED that judgment is entered in favor of the Commissioner and against plaintiff Joseph W. Newman and



intervenor Commercial Technology, Inc., jointly and severally in the amount of \$1,575.79 and it is

FURTHER ORDERED that judgment is entered in favor of the Commissioner and against Joseph W. Newman in the additional amount of \$103,015.48.

Date:

At: Washington, D.C.

THOMAS PENFIELD JACKSON

U.S. District Judge



APPENDIX D

CHART I

